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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Panelfold, Inc.
v.
ChemRex Inc.

Opposition No. 103,270
to application Serial No. 74/650,110
filed on March 22, 1995

Marsha G. Gentner of Jacobson Holman, PLLC for Panelfold,
Inc.

Dyann L. Kostello of Michael Best & Friedrich LLP for
ChemRex Inc.

Before Chapman, Wendel and Drost, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On March 22, 1995 ChemRex Inc. (a Delaware
corporation) filed an application to register on the
Principal Register the mark SONOWALL for goods ultimately
identified as "primers for interior and exterior surface

preparations; protective coatings in the nature of interior and exterior paints; elastomeric coatings for interior and exterior surfaces; elastomeric finishes for interior and exterior surfaces; and stucco base coating for walls." The application is based on applicant's claimed date of first use and first use in commerce of October 17, 1994.¹

Panelfold, Inc. (a Florida corporation) has opposed registration, alleging that opposer manufactures, distributes and sells building products including folding and movable walls and wall partitions; that since long prior to applicant's claimed first use date, opposer has continuously used the mark SONICWAL for folding and movable walls and wall partitions; that opposer owns Registration No. 805,430 for the mark SONICWAL² for "folding wall partitions"; and that applicant's mark, when used on its goods, so resembles opposer's previously

¹ In the application, applicant claimed ownership of Registration No. 416,974 issued October 9, 1945 (second renewal-20 years), for the mark shown below

SONOLASTIC

for "ready mixed paints"; and Registration No. 1,691,077 issued June 9, 1992 (cancelled under Section 8 in 1998) for the mark SONOPRIME for "epoxy/polyamide primer for use on concrete."

² Registration No. 805,430, issued March 15, 1966, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed (20 years). The claimed date of first use and first use in commerce is May 6, 1965.

used and registered trademark as to be likely to cause confusion, mistake, or deception.

Applicant, in its answer, denied the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the opposed application; several notices of reliance filed by each party; and the testimony, with exhibits, of applicant's product manager, Rick Van Garven. Certain matter has been excluded from the record as explained below.³

Both parties filed briefs on the case.⁴ An oral hearing was not requested.

Evidentiary Matters

Before considering the merits of this case, we will decide both parties' pending motions to strike evidence.⁵ Specifically, opposer has filed a motion to strike two of

³ In opposer's amended notice of reliance (filed July 17, 2000), opposer submitted applicant's answer to revised interrogatory No. 5 under seal because the information was designated "confidential" by applicant. However, applicant later submitted a copy of this "confidential" answer as part of applicant's brief in opposition to opposer's motion to strike, and applicant did not submit same under seal. Nonetheless, the Board has not discussed the specific matter contained in applicant's answer to opposer's revised interrogatory No. 5 in this decision.

⁴ Opposer's motion (filed October 11, 2001) and applicant's motion (filed November 30, 2001) to extend the time to file briefs and remaining briefs, respectively, are both granted.

⁵ The two motions to strike have been fully briefed by the parties. (Opposer's consented motion, filed September 24, 2001,

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applicant's June 20, 2001 notices of reliance on (i) some of applicant's answers to opposer's interrogatories, and (ii) applicant's trademark registrations; and applicant filed a motion to strike opposer's August 13, 2001 rebuttal notice of reliance on applicant's answer to opposer's revised interrogatory No. 9.

Turning first to opposer's motion to strike applicant's notice of reliance on some of applicant's own answers to opposer's interrogatories, opposer contends that applicant's reliance on its own answers to opposer's revised interrogatory Nos. 8, 11, 14 and 15 is improper under Trademark Rule 2.120(j)(5) because these answers do not relate to the topics raised in the selected interrogatory answers opposer put into the record by way of its notice of reliance on applicant's answers to opposer's revised interrogatory Nos. 4-6, 10, 13 and 16; and that applicant has not shown how its answers to opposer's revised interrogatory Nos. 8, 11, 14 and 16 should in fairness be considered so as to make not misleading what was submitted by opposer.

Applicant contends that its responses to interrogatory Nos. 8 and 11 regarding actual confusion

to extend its time to respond to applicant's motion to strike is

relate to opposer's reliance on certain of applicant's answers regarding trade channels, and marketing and distribution of these goods; that No. 14 relates directly to No. 13 as is stated in the interrogatory itself; and that No. 15 is an explanation of applicant's business and its products which relates directly to No. 16 inquiring about whether applicant's mark appears on any products sold in the building, interior space and construction industries.

After careful review of the involved interrogatories and the arguments of both parties, we conclude that applicant's reliance on its answers to opposer's revised interrogatory Nos. 8, 11, 14 and 15 is proper under Trademark Rule 2.120(j)(5). Applicant's reliance on its answers to opposer's interrogatories regarding knowledge of opposer and actual confusion (Nos. 8 and 11) relate directly to opposer's reliance on its interrogatories about trade channels and distribution systems (opposer's interrogatory Nos. 4-6). That is, if a plaintiff is attempting to show that trade channels overlap, the defendant is allowed in fairness and so as to make not misleading what was relied on by the plaintiff to show that there has nonetheless been no actual confusion.

granted.)

Opposer's interrogatory No. 14 begins with the prefatory statement "if the response to Interrogatory No 13, above is other than an unqualified negative....," and we find this unquestionably relates in fairness to applicant's answer to interrogatory No. 13 which was previously relied on by opposer.

Applicant's reliance on its answer to opposer's interrogatory No. 15 regarding the nature of applicant's business and the nature of its products also clearly relates in fairness to applicant's answer to opposer's interrogatory No. 16 which asked whether applicant's mark appeared on products sold in the building, interior and construction businesses.

Accordingly, opposer's motion to strike applicant's notice of reliance on applicant's answers to opposer's revised interrogatory Nos. 8, 11, 14 and 15 is denied.

Turning to the second portion of opposer's motion to strike, opposer seeks to strike applicant's notice of reliance on certified status and title copies of nineteen of applicant's trademark registrations (exhibits 22-40), and portions of Mr. Van Garven's testimony, with exhibits 1-12 (see opposer's brief, p. 2). Opposer contends that it specifically sought this information in discovery (opposer's revised interrogatory No. 9), but it was not

produced and in fact, applicant stated it was not aware of any such relevant marks; that opposer objected to this line of questioning of applicant's witness, Rick Van Garven; and that applicant willfully withheld information depriving opposer of legitimate trial preparation.

Applicant contends that in its answer to opposer's revised interrogatory No. 9, applicant objected to the question but stated to the extent it understands the interrogatory there are no such marks; that opposer never actively sought clarification of applicant's answer; that applicant misunderstood interrogatory No. 9 to relate only to third-party marks and registrations; that applicant's answer to interrogatory No. 7(b) regarding the selection of applicant's mark, referred to five other marks owned by applicant, all commencing with "SONO," putting opposer on notice both that applicant would claim a family of marks, and that the two parties' interpretations of opposer's interrogatory No. 9 were different, requiring follow-up by opposer; that opposer never took any action to follow up on this information; that there is no prejudice to opposer; and that applicant acted in good faith by later providing a supplemental response to interrogatory No. 9, referencing its nineteen registrations.

Opposer's revised interrogatories were served on applicant on April 5, 2000, and interrogatory No. 9 reads, in part, as follows:

Identify each mark, trade name or other designation, and each registration, relevant to opposer's asserted rights in Opposer's mark, Opposer's claims herein, and/or Applicant's defense to Opposer's claims herein, and for each:
...⁶

Applicant's answer thereto reads in its entirety as follows⁷:

Applicant objects to the preamble of Interrogatory No. 9 as vague, indefinite and incomprehensible, however to the extent that Applicant understands Interrogatory 9, Applicant is not aware of any mark, trade name or other designation, or registration that is relevant to Opposer's asserted rights in Opposer's mark, Opposer's claims herein, and/or Applicant's defense to Opposer's claims herein.

During applicant's testimony period, on October 6, 2000, applicant took the testimony of its product manager, Rick Van Garven, and when he was questioned about various brochures and technical data guides showing marks other than SONOWALL used by applicant, opposer

⁶ Opposer had previously served (on March 14, 1997) requests for documents including all documents which are responsive to opposer's interrogatories.

⁷ Applicant's answers to opposer's revised interrogatories carry a date of May 5, 2000, and are signed as to objections by applicant's attorney; but the answers are not signed (under

objected thereto as having been asked for in discovery but not provided to opposer; and also as irrelevant because applicant had stated there were no such relevant marks. Opposer specifically moved that this portion of the witness' testimony as well as exhibits 1-12 be stricken. (Dep., p. 23.) Subsequent thereto, on October 31, 2000 applicant served on opposer a supplemental response to revised interrogatory No. 9 stating that in light of the clarification of the meaning of the interrogatory ascertained at the Van Garven testimony deposition (i.e., the interrogatory did not refer only to third-party marks and registrations), applicant identified its nineteen registrations, and answered the subparts of the interrogatory with respect thereto. On June 20, 2001 applicant filed its notice of reliance on certified status and title copies of its nineteen registrations, resulting in opposer's motion to strike same.

Opposer's revised interrogatory No. 9 is not vague and incomprehensible, and there is simply no reference in the question limiting the scope thereof to only third-party marks and registrations. Applicant answered clearly stating there were no marks or registrations

oath) by applicant, and the certificate of service on opposer's

relevant to opposer's claims or applicant's defense of this case. Applicant's actions during the discovery phase of this case would lead any reasonable person to believe that applicant was not relying on any other marks in this case, either of its own or those of third parties. If applicant intended to assert a "family" of marks (the substance of same will be discussed later herein), at a minimum applicant should have answered interrogatory No. 9 by referencing its own marks. Applicant's reference to some of its other marks in answering a different interrogatory regarding the selection and creation of its involved mark is simply not notice to opposer that applicant is claiming a "family" of marks.

Applicant's argument that opposer was obligated to follow up on applicant's answer is disingenuous because applicant's answer was clearly that there were no such marks. It is unfair and prejudicial to opposer for applicant to assert such matters for the first time during applicant's testimony period. See *Weiner King, Inc. v. The Wiener King Corporation*, 615 F.2d 512, 204 USPQ 820, 828 (CCPA 1980). An important aspect of discovery is to enable appropriate trial preparation,

attorneys is dated April 5, 2000.

including cross-examination of the adverse party's witness(es); and in this case, applicant's response to the involved interrogatory clearly stated that there were no relevant registrations, and this would include applicant's own registrations. Simply put, opposer asked a question and applicant answered the question, and applicant is estopped from offering information to the contrary at trial. See TBMP §527.05, and cases cited therein.

This portion of opposer's motion to strike is granted. Accordingly, the objected-to testimony of Mr. Van Garven and testimony exhibits 1-12, and applicant's June 20, 2001 notice of reliance on nineteen registrations are hereby stricken.

Equally important with regard to this testimony, exhibits, and notice of reliance, all relating to applicant's asserted "family" of marks, is the fact that this defense is unavailable to a defendant in a Board proceeding. See *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1052-1053 (TTAB 1992). That is, the only issue before the Board is whether the mark applicant seeks to register so resembles opposer's mark that, when used in connection with the goods at issue, confusion is likely. Consequently, even if

applicant were to demonstrate that it has established a family of marks characterized by the term "SONO," it would not aid or otherwise entitle applicant to the registration which it now seeks. Moreover, in this case, even if the Board considered this evidence it is not outcome determinative and would not change the result herein.

During the Van Garven testimony, opposer made a few other objections to various matters unrelated to applicant's asserted "family" of other marks, but opposer did not raise these objections in its brief on the case, and therefore they are considered waived.⁸ See *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 footnote 4 (TTAB 1990). See also, TBMP §718.04.

Turning now to applicant's motion to strike, on August 13, 2001, opposer filed a rebuttal notice of reliance on applicant's answer to opposer's revised interrogatory No. 9. applicant contends that this is not proper rebuttal; and that a party should not be allowed to introduce evidence in support of its case in chief during rebuttal.

⁸ We are aware that applicant mentioned in its brief on the case virtually all of opposer's other objections made during Mr. Van Garven's testimony, but this cannot cure opposer's waiver of its remaining objections.

Because we have stricken the portions of applicant's case relating to its claim of a "family" of marks, we agree that opposer's rebuttal notice of reliance does not constitute proper rebuttal. Accordingly, applicant's motion to strike this notice of reliance is granted.⁹

Finally, we point out that both parties' briefs contained objections to certain arguments and specific statements made in the other party's brief. Suffice it to say that the Board does not generally strike a properly and timely filed brief, or any portion thereof, but the objections will be considered by the Board in determining the case and any improper arguments will be disregarded. See TBMP §540.

The Parties

Opposer, Panelfold, Inc., is in the business of manufacturing, distributing and selling building, interior space and construction products; and has been engaged in this business since October 1953. Opposer has continuously marketed "folding wall partitions" under the mark SONICWAL since May 6, 1965; and it sells its goods through sales representatives, dealers and distributors

⁹ Inasmuch as we have granted applicant's motion to strike, we do not reach applicant's alternative requests that applicant's answer to opposer's revised interrogatory No. 9 be interpreted in a particular manner and that applicant's notice of reliance

of opposer's products, to architects, interior designers and decorators, engineers, building and construction contractors, and retail stores.

One of the publications in which opposer advertises is "Sweet's General Building and Renovation Catalog." In that catalog, opposer's product sold under the mark SONICWAL is described as an "acoustical folding partition." (Opposer's exhibits 4 and 5.) Opposer is not aware of any instances of actual confusion involving these marks for these goods.

Applicant, ChemRex Inc., has been in existence for approximately 98 years, and it manufactures various building products (e.g., concrete patching materials, waterproof coatings and sealants, curing compounds for concrete products) for the construction industry. Applicant has several divisions, one of which is the Sonneborn division, which itself is divided into separate divisions. Mr. Van Garven testified that the Sonneborn division of applicant would "obtain \$200 million" in sales for the year 2000. (Dep., p. 8.)

In applicant's website it describes itself as "a leading manufacturer of chemical-based products for the commercial-construction and industrial markets," and "a

on its supplemental answer to the interrogatory be admitted into

leading provider of concrete repair and restoration materials and architectural wall finishes in the United States." Further, it explains therein that "Sonneborn products are used in a multitude of new construction and renovation projects... office buildings, manufacturing facilities, condominiums, apartment buildings, hospitals, schools,...." (Van Garven dep., pp. 50-53, and opposer's exhibits 7 and 8.)

Applicant uses the mark SONOWALL for a line of stucco-based products, and such use commenced in October 1994. The prefix "SONO" in applicant's mark SONOWALL was selected based on the history of the "Sonneborn" division name and its reputation for waterproofing experience¹⁰; and "WALL" was selected as the suffix because all of the products in the SONOWALL line are either applied to a wall or used in constructing a wall.

Applicant markets its products sold under the SONOWALL mark primarily to distributors and architects, who, in turn, sell the goods to construction contractors. It advertises and markets in various ways, including in "Sweet's," "Build Core," and "First Source" publications, and through exhibiting at trade shows (such as The Home

the record.

¹⁰ There is nothing further in the record specifically explaining how "SONO" is derived from "Sonneborn."

Builder Show and The World of Concrete), and by providing promotional flyers and other information to distributors to assist them in promoting applicant's products. Sales of applicant's goods under the SONOWALL mark have grown from \$37,000 in 1995 to \$7.5 million in 2000. Applicant spends approximately \$30,000 annually on advertising and promoting the products sold under this mark.

Applicant is not aware of any instances of actual confusion involving these marks for these goods.

Priority

With regard to the issue of priority, because opposer owns a valid and subsisting registration of its pleaded mark, the issue of priority does not arise. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); and *Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995). Moreover, opposer's use of the mark SONICWAL since May 1965 precedes applicant's use of its involved mark, SONOWALL, since October 1994.

Likelihood of Confusion

The only remaining issue before the Board is that of likelihood of confusion. Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors

bearing on the issue of likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Based on the record before us in this case, we find that confusion is likely.

Turning first to a consideration of the parties' respective goods, it is well established that the issue of likelihood of confusion must be determined in light of the goods set forth in the opposed application and pleaded registration and, in the absence of any specific limitations therein, on the basis of all normal and usual channels of trade and methods of distribution for such goods. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corporation, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). See also, The Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715 (TTAB 1991); and In re Elbaum, 211 USPQ 693 (TTAB 1981).

Our primary reviewing Court, the Court of Appeals for the Federal Circuit stated the following in Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990):

The authority is legion that the question of registrability of an

applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.
(Citations omitted.)

In addition, it is well settled that goods need not be identical or even competitive to support a finding of likelihood of confusion, it being sufficient instead that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 1171, 29 USPQ2d 1771, 1773 (Fed. Cir. 1993); and *In re Peebles, Inc.*, 23 USPQ2d 1795 (TTAB 1992).

With respect to the involved goods, we note that opposer's pleaded registration covers "folding wall partitions"; and applicant's identified goods are "primers for interior and exterior surface preparations; protective coatings in the nature of interior and exterior paints; elastomeric coatings for interior and exterior surfaces; elastomeric finishes for interior and exterior surfaces; and stucco base coating for walls."

Opposer's goods include no limitation as to what
opposer's goods are made of, and/or whether the goods are
to be painted or otherwise finished; and applicant's
goods are identified to include paints and primers and
surface coatings and finishes for "interior" use. Here,
opposer makes and sells interior folding wall partitions¹¹
and applicant seeks to register its mark for, inter alia,
primers for interior and exterior surface preparations,
and protective coatings in the nature of interior and
exterior paints. It is obvious that these are not
identical goods, one being folding wall partitions and
the other being various coatings and finishings for
interior and exterior surfaces. However, these goods are
related in the mind of the consuming public as paints and
primers are used to cover walls, whether the walls are
folding wall partitions or more permanent in nature. See
Recot, Inc. v. M.C. Becton, 214 F.3d 1332, 54 USPQ2d
1894, 1898 (Fed. Cir. 2000).

Applicant testified that its goods are intended for
use only by professionals (for example, painters,
waterproofing contractors, plasterers) and are not
intended for use by the general public; that its goods

¹¹ While opposer's identification does not include the word
"interior," it is reasonable to assume that folding wall

are not sold in retail stores; and that applicant's products sold under its SONOWALL mark are only for use on the exterior of buildings, whereas opposer's products are for interior use.

Applicant strenuously urges that the goods are completely different, opposer's folding wall partitions used in hotels and conference centers with soundproofing an important characteristic, while applicant's goods are primers, elastomeric finishes and stucco-based coatings for exterior cladding or construction of new walls in exterior applications or "interior" spaces like parking garages; that the channels of trade are different and even though both parties' products "may ultimately be directed to architects and contractors" (applicant's brief, p. 29), such consumers carefully evaluate each construction project; and that these involved goods are purchased by sophisticated customers after careful consideration.

The problem with applicant's position is that there are no such limitations contained in either opposer's or applicant's identifications of goods. Opposer's identification does not restrict use to hotels and conference centers or as to soundproofing capabilities.

partitions would, at a minimum, include interior wall

There is no restriction in applicant's identification of goods that its primers, paints, finishes, coatings and stucco base coat for walls are sold only to architects or construction contractors. Moreover, applicant has clearly included the term "interior" several times in its identification of goods, yet applicant contends that it does not use these goods on interior room walls or surfaces.

Put another way, applicant seeks to register the mark SONOWALL for goods without any restrictions as to professional purchasers or any specific channels of trade; and conversely, applicant shows that even though its identification specifically includes several references to "interior" surfaces, it actually uses these products only on exterior walls or surfaces.

Because there is no limiting language which restricts applicant's or opposer's channels of trade (e.g., for professional use only, for industrial use only) or limits purchasers to whom the goods are sold (e.g., architects, construction contractors), we must presume that both applicant's goods (primers, paints, coatings, finishes, stucco base coat for walls) and opposer's goods (folding wall partitions) could be sold

partitions.

through all normal channels of trade and to all the usual classes of purchasers. That is, these goods, as identified, could be sold to professionals in the industry as well as the general public through retail stores. In addition to the unrestricted nature of the identifications of goods as to trade channels and purchasers, the evidence actually shows that both parties' products are directed to architects and ultimately to construction contractors. (See e.g., Van Garven dep., p. 26; applicant's answers to opposer's revised interrogatory Nos. 10, 13 and 16; and exhibits 4 and 5 -- "Sweet's General Building and Renovation Catalog.") Thus, there is evidence of the same and/or overlapping consumers. In addition, these goods could be used together in that someone installing a folding wall partition could also prime and paint same.

Further, applicant's product manager testified that applicant's goods are used only on exterior surfaces because the "interior" surfaces meant by applicant are only those not heated and not fully enclosed (e.g., parking garages). However, we cannot ascribe to the word "interior" the meaning described by applicant. We take judicial notice of The Random House Dictionary (Second

Edition 1987) meaning of "interior"¹²: "9. Arch. a. the inside part of a building, considered as a whole from the point of view of artistic design or general effect, convenience, etc. b. a single room or apartment so considered." Thus, it is clear that applicant's identified goods, including the term "interior," would encompass interior rooms and walls.

Even if we assume, as applicant contends, that the relevant purchasers for both parties' identified goods would be sophisticated purchasers, that does not mean that they are totally immune from confusion as to the source of the goods. See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

We find these goods, as identified, (opposer's folding wall partitions, and applicant's primers and paints for interior and exterior surfaces) are related, and may be sold through the similar channels of trade to similar purchasers. It is not necessary that a likelihood of confusion be found as to each item included within applicant's identification of goods. See *Squirtco v. Tomy Corporation*, supra, 216 USPQ

¹² Opposer offered another dictionary definition of the term "interior" in its reply brief (p. 22). While we also take

judicial notice of the definition offered by opposer, we rely on the definition given above. See TBMP §712.

at 939; Tuxedo Monopoly, Inc. v. General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); and Alabama Board of Trustees v. BAMA-Werke Curt Baumann, 231 USQP 408, footnote 7 (TTAB 1986).

We turn next to a consideration of the respective marks at issue. Although the parties' marks are not identical, when considered in their entireties, the respective marks are similar in sound, appearance, connotation and commercial impression. Both marks, SONICWAL and SONOWALL, are three syllable words with similar letter formations and the same beginning syllable and ending syllable. The fact that in opposer's mark the last syllable is "WAL" whereas in applicant's mark it is "WALL" is an extremely minor difference unlikely to be noticed or remembered by purchasers. Of course, when spoken, these marks are highly similar.

Moreover, the slight differences between applicant's mark SONOWALL and opposer's SONICWAL mark may not be recalled by purchasers seeing the marks at separate times. The proper test in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than specific impression of the many trademarks

encountered; that is, a purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrisison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

Potential purchasers may mistakenly believe that applicant's mark used for, among other things, paints and primers is a related version of opposer's mark used for folding wall partitions, with both parties' marks serving to indicate origin in the same source.

Concerning the connotations of the respective marks, we take judicial notice of the following definitions from Webster's Third New International Dictionary (1993): (i) "sonic" is defined as "1. having a frequency within the audibility range of the human ear....2. utilizing, produced by, or relating to sound waves..."; and (ii) "sono" which states "see son-," with "son-" defined as "son- or soni- or sono- ... sound." As applicant argues (brief, p. 22), in opposer's mark "sonic" suggests a reference to sound and possibly a soundproofing quality of its folding wall partitions. And likewise, the prefix "sono" in applicant's mark also suggests the same reference to sound and/or perhaps a sound-deadening

quality in its primers, paints, coatings and finishes. Both parties' marks connote a reference to walls.

Thus, when we compare the parties' marks in their entirety we find that they are substantially similar in sound, appearance, connotation and commercial impression. See *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999). Their contemporaneous use, in connection with these related identified goods, would be likely to cause confusion as to the source or sponsorship of such goods. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 1307, 55 USPQ2d 1842 (Fed. Cir. 2000); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Another du Pont factor we consider in this case is the strength of opposer's mark.¹³ Opposer contends that its mark is "strong" and entitled to a broad scope of protection because its "incontestable" registration for the mark is thirty-five years old, and there is no evidence of any other similar marks in use on similar goods. Applicant contends that incontestability of a registration for a mark does not establish that the mark is "strong"; that opposer's mark is suggestive and not

¹³ This case does not involve a claim that opposer's mark is "famous" within the meaning of the du Pont case as opposer made

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arbitrary; and that opposer has submitted no evidence to establish marketplace recognition of its mark SONICWAL.

clear in its reply brief (p. 14) stating that "Opposer does not seek to rely on the fame of its strong mark."

There is no question that this Board and courts accord to a well-known or strong mark a broader scope of protection than that which is accorded to a mark which is not well-known or strong. However, we do not find the evidence in this record adequate to persuade us of the well-known character of opposer's SONICWAL mark. Mere length of time that a mark is in use does not by itself establish consumer awareness of the mark resulting in a finding that the mark is strong and entitled to a broad scope of protection. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1992).

Likewise, the fact that a registration has achieved incontestable status does not make a mark "strong." See e.g., *Oreck Corporation v. U.S. Floor Systems, Inc.*, 803 F.2d 166, 231 USPQ 634, 638 (5th Cir. 1986). Opposer has not shown any reason why its mark should be afforded more than the normal scope of protection.

Applicant's argument that there has been no actual confusion is unavailing as there is little evidence of record regarding either opposer's or applicant's geographic area of sales (e.g., applicant answered opposer's interrogatory No. 6 regarding channels of trade and manner of distribution with "Applicant's products are sold directly to Distributors in targeted geographical

areas"); and there is no evidence of opposer's sales. Hence, it is not clear that there has been opportunity for confusion in the marketplace. Moreover, the test is whether there is a likelihood of confusion, not whether actual confusion has occurred. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

Applicant argued that "the potential for confusion is nonexistent." (Brief, p. 36.) We disagree with applicant's statement that the potential is "nonexistent"; and we note that applicant's argument is unsupported by any evidence specifically relating thereto. While it is true that the Board (and the courts) are concerned with more than mere theoretical possibilities of confusion, mistake or deception, in this case we find there is more than such a mere theoretical possibility, there is a likelihood of confusion in this case.

Finally, opposer contends that with regard to applicant's intent, applicant adopted its mark almost thirty years after opposer's mark registered; and that despite applicant's duty to select a mark sufficiently distinguishable from opposer's mark to avoid a likelihood of confusion, it did not do so. Applicant contends that

there is no evidence and nothing to infer bad intent on applicant's part in adopting its mark; and that in fact, applicant was not aware of opposer until becoming involved in this opposition.

There is no evidence that applicant was previously aware of opposer's mark SONICWAL. Even if opposer had established that applicant was so aware, that could not, by itself, establish wrongful intent. Mere knowledge of another's mark does not establish bad faith or wrongful intent. See *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797-1798 (Fed. Cir. 1987); and *Electronic Water Conditioners, Inc. v. Turbomag Corporation*, 221 USPQ 162, 165 (TTAB 1984). Even though there is no evidence of any bad intent on applicant's part in adopting the involved mark, and even if applicant established innocent or good faith intent, it is unpersuasive of a different result in this case. As the Court of Appeals for the Federal Circuit stated in the case of *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991): "Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered, but the absence of such evidence does not avoid a likelihood of confusion."

Based upon consideration of the evidence and weighing all relevant du Pont factors, we find that because the parties' marks are similar; the parties' goods, as identified, are related; and the trade channels and purchasers of the respective identified goods are similar or overlapping; there is a likelihood that the purchasing public would be confused when applicant uses SONOWALL as a mark for its goods.

Decision: The opposition is sustained, and registration to applicant is refused.